

### **REMARKS**

Claims 1-49 are pending in the instant application. Claims 1-10 and 23-49 previously withdrawn for being drawn to a non-elected invention are now cancelled without prejudice. As the claims were cancelled in response to a restriction requirement, no equivalents are surrendered. Applicant reserves the right to pursue the claims in one or more divisional or continuation applications. Claim 50 has been added. The amendment is supported throughout the specification, for example, page 6, lines 33-35 of the application as filed. No new matter is added by the amendment. After entry of the amendment, claims 11-22 and 50 will be pending.

### **Information Disclosure Statement**

Applicant thanks the Examiner for consideration of the references listed in the Information Disclosure Statement. Applicant notes that the Examiner crossed through the Stahl reference stating that it was not in the file. Applicant respectfully disagrees. The attached document was downloaded from Private PAIR by Applicant and is indicated to have a USPTO mail room date of August 1, 2006. Applicant requests that the Examiner consider the reference and provide an initialed SB08 indicating the same. If a rejection is made based on the reference which was provided to the Examiner in a timely manner, it is requested that the rejection be non-final.

### **Claim rejections under 35 U.S.C. §102**

The Office Action has rejected claims 11-13 for allegedly being anticipated by Scholin et al. (US Patent 6,187,530, hereinafter the '530 patent). Applicant respectfully disagrees.

The Office Action has characterized claims 11-13 as providing "a method to characterize cells in an environment, said method comprising the steps of collecting a sample through an automated device and subsequently processing the samples," and

applies the Scholin reference to the claims based on this characterization. Applicant notes that the claimed method includes the use of a device including at least:

1. An array of capillary microcosms for trapping cells; and
2. A housing surrounding the array and having an opening to controllably permit cells from the environment to access the array.

The cited art does not teach capillaries. Therefore, the instant claims cannot be anticipated by the cited art.

The cited art includes a filter disc, not an array of capillary microcosms. The Office Action asserts that "the filter disk is absorbing the microorganisms through capillary action. Thus, each disk is considered to be an array of capillary microcosm wherein cells are trapped." Applicant respectfully disagrees. Applicant points to a number of portions of the specification of the '530 patent to demonstrate that the water is drawn through the filter, not by capillary action. Applicant notes that neither the word "capillary" nor "capillaries" is present in the '530 patent. However, the specification of the '530 patent includes the following description of the use of the device provided therein:

The "process" position is where the **water sample is passed over the filter disk 31**. (col. 9, ln. 12-14)

A valve 51 on a valve manifold 1 is then opened to the environment and a **water sample is acquired into the syringe 3 and passed over the filter disk 31**, retaining particles on the filter disk 31 as **the water is pulled through the filter disk 31** as the piston 52 is lowered. (col. 9, ln 17-21) [emphasis added in each passage]

It is clear from these passages of the specification that the water is not moved through the filter by capillary action. Instead, the water is actively pushed or pulled through the filter. This aspect of the teachings of the cited art is even noted in the Office Action which states:

The filter housing holder, slidably mounted on a linear shuttle, moves the filter housing into a process position, **where a syringe draws fluid in through a valve manifold and through the filter disk** to collect samples on the filter disk. [emphasis added, page 3]

Applicant submits that one of skill in the art could not understand the cited art to teach that water moves into or through the filter by capillary action.

There are several significant differences readily evident between a capillary microcosm for trapping cells, as claimed, and a filter disc. Applicant provides the following definition of "capillary" from the Random House Webster's Dictionary (Third Edition, 1993)

capillary: -- n. 1. one of the minute blood vessels that connect the arteries and veins. 2. a tube with a small bore.  
-adj. 3. pertaining to capillaries or capillarity. 4. like hair.

Based on the ordinary definition of capillary and the claimed limitation of trapping cells, one would understand that the capillary would contain a lumen (as a blood vessel) or small bore so that the capillary could contain material. Further, the specification describes the capillary array in agreement with the ordinary definition on page 10, lines 2-4 which states:

The capillary array includes a plurality of test chambers, or microcosms, each adapted for containing a cell sample (e.g., microorganisms or tissue samples) or a sample of a test compound.

A filter disc cannot be used for containing a cell sample or sample of a test compound. Based on the ordinary definition of capillary, one would understand that the capillaries of the instantly claimed invention "can be provided with any media for required for maintaining the viability of the tissue sample." This is clearly distinct from the use of a filter.

Therefore, even if the water were moved through the filter by capillary action, which it is not, the '530 patent does not provide the physically claimed structure of an array of capillary microcosms.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

A filter is not expressly or inherently an array of capillary microcosms as claimed. Moreover, one of skill in the art would not consider a filter to anticipate an array of capillary microcosms as claimed. As each and every element set forth in the claim is not found in the cited art, the rejection is improper and must be withdrawn.

#### Claim rejections under 35 U.S.C. §103

The Office Action has rejected claims 11-18 and 21-22 under 35 U.S.C. § 103 (a) for allegedly being obvious over combined teachings from the '530 patent cited above in view of Köster et al. (US Patent 6,730,517 B1, hereinafter the '517 patent) and further in view of Iola et al (hereinafter Iola).

Applicant respectfully disagrees. The references in combination would not allow one of skill in the art to arrive at the instantly claimed invention.

The rejection characterizes the invention as "a method for collecting a sample through an automated device and subsequently processing the samples." The characterization of the claims in the obviousness rejection do not consider the structural feature of an array of capillary microcosms. For at least this reason, the rejection fails for the same reason as the anticipation rejection set forth above.

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on applicant's disclosure or **the mere fact that the**

**components at issue are functional or mechanical equivalents.** *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (see MPEP 2144.06(II))

The mere fact that cells are collected on filters or in capillaries in the devices does not suggest that their equivalency is recognized in the prior art.

Neither the '517 patent nor the Iola reference provide any teaching or suggestion related to "an array of capillary microcosms for trapping cells" as instantly claimed. Therefore, neither of the references alone or in combination can overcome the deficiencies of the '530 patent. Withdrawal of the rejection is respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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